

Application/Control Number: 09/924,227
Art Unit 2626
First Named Inventor: Blair, John
Examiner: Worku, Negussie

Reply to Non-Final Office Action Rejecting Claims and Request for Reconsideration

1. No disagreement regarding the definition of 35 U.S.C. 103(a) and its basis for rejecting claims based on obviousness is asserted.
2. Claims 1-8 Kagami et al. in view of Kadota –

To preface, the Blair Application discloses an integrated system wherein a scanner contains a built-in digital media reader (card reader) combined with USB (and other bus ports) wherein the mere insertion of a digital film card initiates a scan, display of the digital images from said card, and provides proprietary software for post process manipulation of the digital image data (i.e. the ability to view, edit and send to a photo processing company via the Internet).

Kagami discloses an image scanner connected to a computer including various controls for sending image data from a scanner to a computer. Kagami does not teach said devices being connected to a USB device or port of a computer. The Examiner asserts to combine Kagami with Kadota, wherein Kadota teaches an apparatus connected to at least one USB system of a computer. Arguably described as a “port” for the sake of clarity herein.

With respect to claims 1 and 2 (not easily separable for argument purposes) of the rejected application, the Examiner reports Kagami as detailing a system at Col. 6, lines 47-53 comprising “at least one of a Compact Flash Memory card reader, a Smart Media card reader, etc.”. In both Fig. 2 of Kagami and in the aforementioned column and lines, the Kagami patent does not disclose any of the aforementioned card readers, but rather discloses an external device “(image reader or image scanner IR)”, which is not analogous technology to a card reader for the purposes of retrieving digital data therefrom. In Fig. 3 of Kagami, the Examiner points out 31(a) and (b) as providing “flash memory”. The references on Fig. 3 detail storage memory functionality and are directed to the scanner storing memory of the image it has scanned, and reporting such image data back to the connected computer. Col. 6, lines 45-50, “The memory unit 31 linked to the image processing circuit 30 comprises twin arbitrarily accessible memories 31a and 31b such as random access memories (RAM), so that the image data is stored in one of the twin memories...”. This is not analogous to a card reader existing as its own input within a scanner. There has been no digital “reading” but rather an actual scan of a document in the Kagami patent.

Further, the total nature of the Kadota patent is one of assignment and identification of ports resident on a computer wherein the computer identifies and assigns name data to those ports, and further identifies the type of device connected to said ports. Kadota discloses at Col. 1, Line 35, "a computer wherein the user can easily distinguish between the different image processing devices and select a device from the plurality of devices". Such language merely describes a computer with the ability to define the device ports contained therein or connected thereto. Further, at Col. 3, Line 25, Kadota teaches "... display means capable of displaying a port name connected to the computer; display means capable of displaying a port name connectable to each image processing device...".

In the present art, and even the art at the time of filing, such a port containment and identification method is standard for a computer to operate with any devices attached to external ports on said computer. Claim 1 of the rejected application is necessary as a parent claim in order to allow dependant claims to detail the invention as a whole, specifically, a scanner connected to a computer (preferably the USB port thereof) wherein the scanner itself contains a digital card reader or readers. Further, Kadota does not suggest a scanner connected to a USB port wherein data from an embedded card reader or even an attached card reader may be obtained.

With respect to claim 3, the Examiner asserts that "Kagami discloses an apparatus comprising simple control means for directing complex operations of said control unit...", "software means", and a "one-button" functionality for directing the control circuit. In the Blair Application, claim 3 describes control means for directing the operations of a control unit as in a card reader type device. In Kagami, the method disclosed is a "Centronics connector TC mounted on the computer [serving] as an interface relative to a printer PRT (as shown in Fig. 1 and generally has data output lines..." (Col. 5 lines 30-40). This area of the Kagami patent is describing the relationship between a parallel connection of a computer as communicating to an input device such as a scanner. This is not analogous to the Blair claim 3 which depends from claim 2 and discloses a card reader type port. Also see Col. 5, lines 10-20 in Kagami for an overall description of this portion of its invention. Further, there is no mention of "one-button" functionality in Kagami as the Examiner asserts. No such button interface relationship on a scanner is disclosed or described therein. In fact, such a feature is intrinsic to the Blair Application (Claim 3(a)) as Visioneer, Inc. has marketed its trademarked "One-Touch" feature since it began manufacturing scanners.

With respect to claim 4, the Examiner asserts that Kagami teaches a scanner comprising all of the mechanical aspects of any typical flatbed scanner. Kagami teaches in essence, a centronics type connector to be interfaced between a computer and devices such as a scanner and a printer, wherein without such connector, only one device would be able to operate from the single computer port. In other words, the Kagami adapter creates a situation wherein a single port may have multiple devices connected. See Col. 3, line 5, wherein the "use of a general interface connector mounted commonly on an image processor such as a general purpose personal computer without use of a dedicated

interface". A scanner is not claimed, but is used as an example of an external device which may be attached to the Kagami connector. The rejected application discloses a scanner and uses the descriptions as provided by the Examiner, however, such descriptions are necessary to disclose that a scanner (with one or more card readers onboard) is the image reading device being claimed as a portion of the entire invention. These arts are not analogous. The rejected application claims nothing of an interface connector for splitting the use of a computer port.

With respect to claim 5, the Examiner addresses the Kagami patent as disclosing "an image input step for inputting image data into a control circuit within said apparatus; a transmittal step for sending said image data from said control circuit through (interface I/F of Fig. 2) of said computer, etc.". Claim 5 of the rejected application specifically claims image acquisition via a USB port, and the ability to send and receive image data therefrom to a control circuit in concert with control software. Kagami's Fig. 2 is a very generic control circuit wherein the data is being sent from a computer to the Kagami inventive connector, and finally to the input ports of connected devices. None of the Kagami port references are USB ports. Further, the communication is a different mode than that of the Blair application and not analogous art even if combined with Kadota, which the Examiner does not suggest in this portion of the rejection.

With respect to claim 6, the Examiner asserts Kagami as disclosing a method wherein "said image input step comprises detecting (IR image reader or scanner, as shown in Fig. 1 and 2) the insertion of the appropriate media into at least one of a Compact Flash Memory card reader, Smart Card reader, etc.". Kagami neither discloses nor claims any card reader inputs. As explained above, Kagami discloses a centronics type connector wherein, as an example, both a printer and a scanner could be connected to a single computer port using the Kagami connector. There are no references to card readers in the Kagami patent. Additionally, there are no references to card readers in the Kadota patent.

With respect to claim 7, the Examiner again asserts the "button" feature of Kagami as disclosing a "method further comprising simple control steps for directing complex operations of said control circuit (control unit 40 of Fig. 2) and said control software directly from outside of said apparatus...". In the Blair application, a scanner containing buttons for direction of commands to a control system is certainly claimed. In the reference Kagami, there are no buttons on their claimed invention (which is a centronics type interface connector), and, further the Blair application teaches buttons for control of the scanner specifically. Kagami makes no such references. The software as disclosed in the Blair application is the software that controls the functionality between the button on the scanner, and its subsequent interface with a connected computer.

With respect to claim 8, the Examiner again quotes the language of the Blair application, as detailed in the claim 6 section above, as somehow corresponding to the Kagami patent in terms of claiming a scanner. Kagami does not claim a scanner. Kagami merely uses a scanner as one example of a device which may be connected it its inventive centronics type interface connector and a computer.

When applying a §103 rejection, several elements are required. Specific to this rejection, analogy in the arts has not been applied properly. The claimed invention of the Blair application as a whole was not considered properly. First, the Kagami and Kadota patents are not analogous as neither teaches or suggests a scanner with a digital card reader embedded therein. The Examiner references some very generic control circuit language which is germane to any electronic device containing a circuit board. This referencing, however, does not speak to the invention of the Blair application in any rational manner. As in Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Federal Cir. 1993), the art in the reference patents is not within the field of endeavor of the rejected application invention.

The claimed invention as a whole must be considered. The Blair application claims and discloses a scanner wherein one or more digital card readers are a hardware and software integration of said scanner. The communication is accomplished via a USB port on a connected computer. The Kagami reference discloses a centronics type adapter to essentially extend a computer port to more than one external device. The Kadota patent discloses a method wherein a computer may assign identification data to a computer port and similar name data to an external device. Digital card readers are not a part of either application. The suggestion of combining the two patents is completely unsupported as not even approaching analogous art. The Blair invention was, at the time of filing, a completely novel device – a scanner with digital card reader ports on board.

3. No disagreement regarding the definition of 35 U.S.C. 102(e) and its basis for rejecting claims based on obviousness is asserted.
4. Claims 9-19 as being anticipated by Manolis et al. (USP 6,583,799) –

With respect to claims 9-11 of the rejected application, the Manolis patent discloses a method of uploading image data to a remote computer such as a server. As detailed in Col. 4, lines 62-65 of the Manolis patent, “a viewer is launched (step 301). The viewer could be a browser such as Internet Explorer, available from Microsoft Corporation...”. This first step of the Manolis patent is non-analogous to the rejected application. In claims 9-11 thereof, what is claimed is a method which monitors the input means of an image acquisition device, a digital card reader, and if an image or images are present, said image or images are selected and transmitted from the reader (embedded within the scanner) to the attached computer. Claim 11 further discloses the relationship of the scanner to the image acquisition process in the case of absence of a card in the card reader, but wherein the user has placed a medium to be scanned on the scanner. In none of claims 9-11 of the rejected patent is there a prior launch of any viewers or browsers as is inherent to the first step of the Manolis patent.

With respect to claim 12, which admittedly depends from claim 9 via 10 and 11, an application is launched that may include an application to transfer image data files to an Internet-based photograph printing company, an application that launches user’s email service, a fax program, a printer selection menu, or an archive program to store on the

user's computer. The Manolis method requires the user to launch an application and "drag and drop" image files derived from a digital camera connected to the user's computer to its desktop or other storage location thereupon. Subsequently, the image files are organized for transfer to a remote photograph printing company. In order to exist as an attachment to an email program, the Manolis patent requires the image data file to be first stored on the User's computer, the desktop as specified at Col. 6, lines 36-43, and dragged onto the open email application. The rejected application's Fig. 2 shows the process inherent to the presence of a digital card as inserted into the card reader on board the scanner. Once a card is inserted 14, and an image is detected 22 the image application applet is launched 2 as a result of card insertion alone. If no card is present in the card reader, Fig. 3 discloses the steps for the depression of a button on the scanner to initiate the same process wherein a medium is scanned and the image application applet is launched.

Contrary to the Examiner's assertion specifically in regards to claim 11 of the rejected application, the Manolis patent does not disclose a method "determining whether there is a scanner associated with said image acquisition apparatus". The Manolis method of acquiring images is via a digital camera attached by a cable to the user's computer. Further, contrary to the Examiner's assertion as to claim 12, the Manolis patent does not disclose an "application that launches said consumer's email [fax or printer] program". In Col. 6, lines 38-45 the Manolis patent discloses that "the user optionally can attach the image file to an email message before it is sent. In this embodiment, the user can simply drag and drop it into a message text region and the image file can then be sent". There is no reference to launching or using a fax or print program, or an archiving method in the Manolis patent, as there is in the rejected application. In the rejected application (Page 5, paragraphs 0050-0052), the system checks to see if there is a card in the scanner's card reader. If yes, the system checks to see if there is more than one image on the card. If yes, the system checks to see if one of the buttons on the scanner has been pressed (fax button, email button, etc.) and the image application selection applet runs and allows the user to select one or more of the images. If the email button has been pressed, the system creates an email with the image files as attachments and launches the user's email client. If only one image was present the applet is not run and the image is automatically attached to an email or a fax within the user's applications, which are, again, launched automatically. This is vastly different than the Manolis application.

Claims 13-19 of the rejected application disclose the persistent monitoring method for the aforementioned determination of whether a card is present in the card reader, or whether a medium is placed in the scanner to be scanned. The inventive method perpetually monitors the system to determine if there is a card in the scanner's card reader, and if any scanner buttons have been pressed. With respect to claim 13, the Manolis patent Figs. 1-5 do not illustrate a method "wherein said consumer can selectively configure said computer application choices" as in the rejected application. The referenced Manolis Figs. Illustrate the process of a computer having a digital camera connected thereto and a network connection is present (Fig. 1). Figs. 2-5 illustrate the process of acquiring the image data files from the connected digital camera, converting

them to thumbnails, and uploading them to a remote server via the network connection of Fig. 1. The rejected application's method of configuring application choices is illustrated in Fig. 4. A combination of low and high level drivers are used so that application process run separately and are not dependant on the system kernel drivers. The hardware buttons on the scanner are configurable in terms of their link function to software applications such as the user's email client, or a fax program. The hardware buttons are then dedicated to that link and depression thereof causes that application to automatically launch with the image file or files attached and ready to send. See page 5, paragraphs 0053-0055. Again, non-analogous to the rejected application's method or purpose.

With respect to claim 14, the Examiner asserts that the Manolis patent process described at Col. 1, lines 45-50 is equated with claim 14's process of the rejected application. Manolis describes a "digital camera that enables users to take pictures...and save them in digital format". Further, "after taking and storing the images, the user can connect the digital camera to a computer system" Col. 1, line 52-53. The computer system of Manolis as described by the Examiner (100 of Fig. 1) and camera (108 of Fig. 1) are just that – a computer wherein a user has connected a digital camera with a cable to an external port. The rejected application claim 14 discloses the "computer readable media" which is the digital card reader embedded within the scanner itself, and the monitoring means by which the inventive method determines if there is a) a card in the card reader, b) images on the card, and c) if the user has pressed a button on the scanner or whether automatic image application selection will occur (the "consumer selected computer application").

With respect to claim 15, the Examiner claims that Manolis "inherently performs the execution steps of the system computer (100 of Fig. 1)". Here the Examiner equates the buttons on a digital camera to that of the hardware buttons on the rejected application's scanner. The buttons on the latter are configured, as detailed previously, to be hardwired to specific applications such as a user's email program, fax software, etc. These scanner buttons should not be confused with the on/off button on a digital camera. There is no link from a camera to such external, driver-separate applications as with the inventive scanner buttons, which launch programs and attach image files thereto. The process is not inherently the same.

With respect to claim 16, again the Examiner quotes the claim language "determining whether there is a scanner associated with said image acquisition device" and asserts to equate that with the Manolis digital camera. Claim 16 is very specific in its disclosure that the computer executable steps direct the computer to detect if there is a scanner which specifically contains no card reader in the reader slot, and if none, then to alternately scan whatever is on the scanner's platen. A digital camera cannot scan images, nor is there any related computer executable code in Manolis that tells the system there is a scanner connected to a computer, and to scan the item on the platen if no card reader is present in the card reader slot of that scanner.

With respect to claim 17, Manolis discloses "an embodiment that uses image data uploaded by the system of Fig. 3 in an application for handling photographic print

images. The front end interface subsystem includes one or more web application systems 502, one or more image servers 504, one or more image processing servers 506, and one or more upload servers 508, all of which connect to a switch 510” (Col. 8, lines 45-54). Contrary to the Examiner’s assertion, this portion of the Manolis patent does not disclose “instruction sets that direct a computer to launch an application that allows the user to customize which applications are launched with which parameters at the press of which buttons on said image acquisition apparatus...”. This portion of the Manolis patent, as specified in its detailed description of the drawings, serves simply to send packet data of photographic image files to a web application system. Additionally, no button activation is involved.

With respect to claim 18, again Manolis Fig. 7 does not illustrate “computer readable media”. Fig. 7 of Manolis illustrates the process of transmitting an image file through the Internet to a photo lab subsystem. As in the rejected application, claim 18 details the distinct separation of high and low level drivers and independent of the kernel drivers as a novel method for processing images retrieved from the on-board card reader within the scanner. Note the preamble of rejected claim 18; “Computer readable media comprising one or more computer executable instructions sets...”. This is a non-analogous field of endeavor.

With respect to claim 19, again the Examiner asserts Manolis Fig. 7 as teaching a computer readable media. As explained above, it does not. Further, claim 19 discloses the process of persistent monitoring of the media inserted in the scanner’s card reader or item on the platen of the scanner. The processing occurs using a boundary with the kernel driver, low level driver, and high level drivers. The program launching application of claim 19 b) “runs in a process separated from said persistent monitoring process”, and d) “said button configuration application runs in its own process, separate from said persistent monitoring process”. Claim 19 details the process of detection of a card in the card reader or the depression of a button on the scanner wherein the processing of image data therefrom is performed separate and apart from the persistent monitoring process. The Examiner references the Manolis “drag and drop” process whereby an image file has been saved to a user’s desktop and may be dragged onto the text portion of an email to be sent as such (Col. 6, lines 36-43). Further, the Examiner’s mention of the low level drivers and high level user interface as a “keyboard or mouse” is inaccurate in this scenario. The drivers pertaining to the rejected application are internal CPU processing drivers and not, in this embodiment, directed to a mouse or keyboard functionality.

5. No disagreement regarding the definition of 35 U.S.C. 102(e) and its basis for rejecting claims based on obviousness is asserted.
6. Claims 20-22 as being anticipated by Yoshida et al. (US 20010049633) –

To preface, the Yoshida application is directed to a mediation system between a user ordering product and the supplier of said product, herein a printing lab, wherein price tables are utilized to maximize the profits to said user and said printing labs.

With respect to claim 20, the Yoshida application does not provide the user an ability to select certain images for processing that have been displayed on the user's computer screen. Page 3, [0030] of Yoshida, "In the printing mediation system, shop 1a, 1b as an orderer receives the order of printed matter such as postcards or business cards from a user and orders from printing mediation center 2 as a mediator". First, the printed matter in Yoshida are not digital photographic images as in the rejected application, but pertain to printed matter such as business cards. The "current price table" (claim 20 b)) in the rejected application pertains to the photo image processor's pricing without mediation via a secondary source such as in Yoshida. Further, the rejected application provides for a method of accessing electronically a list of special offers from the product supplier (2 for 1 offers, half price offers, etc.). Yoshida provides a method wherein the mediator determines from multiple printing shops, the price for particular quantities of printed matter and returns a price to the user in accordance with a selection of one or more of the printing shops (Page 3, [0032-0033] Yoshida). No ability to access special offers from a specific photo printer is offered. Contrary to the Examiner's assertion, Yoshida, at Col 4, paragraph 38 describes the Yoshida mediation system as "price shopping" between multiple suppliers, and not the determination of "special offers" from a selected photo printing shop and subsequently applying qualified offers to the user as in the rejected application claim 20.

With respect to claim 21, the rejected application claims "computer readable media comprising one or more computer executable instructions that, when executed, direct a computer to: a) provide the customer with the ability to select images for said product ordering from images on said customer's computer". This step is inherent to the rejected application's inventive process and is a result of a digital card reader having retrieved digital images therefrom, or a scanner image from the inventive scanner. Subsequent to the card reader images being displayed on the user's computer screen, the user can select which images are to be sent to a photo printer to be printed and returned to said user. Again, the "special offer" from said photo printing shop can be accessed and applied, if applicable, to that user's order. This is non-analogous to the Yoshida mediation system wherein multiple printing shops (for printed matter such as business cards and not photographs) are sought for price based benefit. There is no method in Yoshida that seeks anything outside of the multiplicity of printing shops standard price tables as manifesting as a benefit to a user ordering photographic prints from digital image files.

With respect to claim 22, again, "computer readable media" as in the rejected application claim means digital image files as retrieved from a card reader embedded in the inventive scanner or a scan that occurs as a result of button depression. Yoshida does not address the method by which the images have been acquired nor their individual selectiveness from the user's own computer. Further, the intricacy of the rejected application's method is illustrated by the separation of driver processes inherent to the user's computer system and manifests as activity conducted on the user's computer prior to any transmittal via to Internet or other method. The Examiner is mistaken as to the processes conducted in the rejected application in terms of the kernel drivers, low level drivers and high level drivers.

In summary, the references used by the Examiner are not easily combinable to form a §103 obviousness rejection. They do not address the inventive method or apparatus in the rejected application, nor are they even analogous art. An obviousness rejection must consider the invention as a whole, which the Examiner in this case has not done. The rejected application claims a scanner with digital card readers embedded therein, a process whereby the user can display and select particular images, and may then send them to a photo lab for processing. Further, special offers from that particular photo processing lab may be ascertained electronically, and applied to an order. All the inventive processes are uniquely conducted via separate processes - that is independent of other CPU functions on the user's computer. A novel use of low level drivers, high level drivers, and kernel drivers are described in the rejected application.

The references used to formulate a §103 rejection do not suggest a combination because they do not disclose similar fields of endeavor. Kagami discloses the shared use of a centronics port on a computer via a connector, Kadota discloses a method for identifying and naming specific ports of a computer and the devices connected thereto.

The references used to formulate a §102(e) rejection do not address the claimed invention in the rejected application. Manolis discloses a method for acquiring images from a digital camera connected to a computer. The rejected application discloses card readers embedded in a scanner. The scanner being the integral and a novel portion of the invention. Manolis does not provide automatic linking of buttons of a digital camera to reactions from software applications such as the buttons on the rejected application's scanner. Manolis requires an image file to be saved onto a user's desktop and then dragged and dropped into the text portion of an already launched user's email application. The rejection application's scanner buttons are hardwired to automatically read the images on the card in the scanner's reader, launch the user's email application and attach the file. Additionally, the rejected application method can perform the same functionality with a fax program, wherein Manolis cannot.

Yoshida is an application which was published after the filing date of the rejected application, but is used in combination with the §102(e)/§103 rejection. Yoshida discloses an order mediation system as between the customer of a printing shop, as for ordering printed matter such as postcards or business cards, wherein such mediation system "price shops" multiple printing shops based upon their published price sheets. The rejected application method accesses a single photographic printing shop, and electronically access any "special offers" and applies them to the user's order. This is not as static a process as Yoshida, which relied only on published price sheets of multiple printing shops.

It would be a very thin stretch at best to attempt to combine the references quoted by the Examiner to reject the Blair application. The invention as a whole has not been considered, the prior art does not read on the invention, most of the references quoted are non-analogous art, and it would not have been obvious to combine references to come up with the inventive scanner and software method as disclosed in Application 09/924,227.